UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

Application Number: 10/006,637
Filing Date: November 08, 2001
Appellant(s): PARRY, TRAVIS J.

MAR 0 4 2008

Technology Center 2100

Todd A. Rathe, Reg. #38,276
<u>For Appellant</u>

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 3, 2007 appealing from the Office

action mailed December 29, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,782,495   Bernklau-Halvor   8-2004

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 7, 8, 9, 21 and 26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The amendment and newly presented claims include the limitation (and its variations) of error messages "automatically conveyed over the network with a web server in response to detection of the transmittal error". According to Appellant's the specification at paragraphs [0028] - [0030], the errors are conveyed after being detected. This is not exactly the same as being "in response to detection", in fact Appellant narrows the timing of the message sending. Adding greater specificity to the timing through amendment is the new matter. Applicant's amendment introduces new matter with the concept of "responsive to detection".

Claim 27 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled

in the relevant art that the inventor(s), at the time the application was filed, had

possession of the claimed invention. A "first plurality of printers .... running a first set of

software programs" and "a second plurality of printers" "running a second distinct set of

software programs". Applicant's disclosure as originally filed does not divulge the

concept of "distinct" software programs. Inclusion of such a concept is new matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 21, 26 rejected under 35 U.S.C. 102(e) as being anticipated by USPN Bernklau-

Halvor, US 6,782,495 B2 (referred to as Bernklau-Halvor)

Regarding claim 21, Bernklau-Halvor taught a system for garnering information on

printer errors (abstract), comprising:

a plurality of printers (column 4, lines 10-19), each printer incorporating a web server

linked to a network (column 6, lines 16-28), each printer including an error detector for

detecting error in printing functions (column 4, lines 45-55; column 6, lines

34-35);

at least one receiving computer in communication with said network, said at least

one receiving computer having a memory thereon (column 11, lines 21-29); and

at least one online error database stored within the memory of said at least one

receiving computer, said at least one online error database capable of receiving an error

message generated by any of said plurality of printers (column 15, lines 27-31) and

conveyed over said network (column 15, lines 27-34), wherein the printer is configured

to automatically generated and convey the error message over the network to the at

least one online error database upon detection of an error (column 15, lines 27-31).

Regarding claim 26, Bernklau-Halvor taught a method (abstract) comprising:

detecting a first error at a first printer incorporating a first web server (column 4, lines

45-55; column 6, lines 34-35);

generating a first error message at the first printer (column 6, lines 34-35);

conveying the first error message to a first online error database with the first web

server over a network (column 6, lines 16-30);

detecting a second error message at the second printer incorporating a second web

server (each printer is capable, column 4, lines 10-19; column 6, lines 16-23);

generating a second error message at the second printer (column 6, lines 34-35);

and

conveying the second error message to the first online error database with the second

web server over a network (column 6, lines 16-30), wherein the taught the first error

messages are automatically conveyed to the online error database in response to the

detection of the first error (column 15, lines 27-31).

(10) Response to Argument

Appellant argues – "Thus, Paragraphs [0028] and [0029] describe that if error detector 23 detects an error (Paragraph [0028]), then the error messages conveyed with a Web server (Paragraph [0029]. Nowhere do Paragraphs [0028] or [0029] describe or even mention any necessary intervening trigger or input before the error message is conveyed by the Web server. "

By using the terminology then Appellant specification, the broadest reasonable interpretation is hinges on the acceptable meanings of "then". The term "then" would comprise a next step or action needs to be performed. However, "then" includes that the next step is performed with or without delay. Also, "then" does not exclude possible intervening steps. The "broadest reasonable interpretation is consistent with the specification".

Appellant argues – "Those of ordinary skill in the art clearly would understand the "if-then" description in Paragraphs [0028] and [0029] as describing an automatic response. Software or other programmers would clearly understand this relationship and meaning."

If the context of the corresponding paragraphs of the specification were related to software code itself Appellant's comment would be true. However, the context of the specification is how the system (which executes the software code) operates not how the software code is constructed.

Appellant argues – "Although Paragraphs [0028 and [0029] do not 'exactly' use the term 'automatically', there is no *in* haec *verba* requirement for claim limitations..."

The context of the paragraphs cited does not convey "automatically" as recited by Appellant's claim language. The "automatic" action refers to collecting "error messages" not sending "error messages". Therefore, Appellant's specification does not support "automatically" in the context associated with the claim language.

Appellant argues – "Paragraph [0032] discloses that error messages from a first printer running a first software program may be sent to a first database while error messages from a second printer running a second software program may be sent to a second database. " "Paragraph [0032] clearly supports the concept of multiple databases 60 which receive error messages from particular printers based upon the type of software programs running on such printers. Paragraph [0032] clearly supports printers running distinctive software programs, wherein there error messages from such printers having distinctive software programs are sent to different databases 60."

Although Appellant's disclosure provides for a "certain" plurality of software programs sending error messages to databases 60. The disclosure does not provide guidance on whether a different software program is associated with a different database. The specification is silent as to the exact permutations of the arrangement that would be available. For example possible permutations are: each software program sends to a corresponding database, each software program sends to all the databases or some

software programs send to some databases. Appellant's disclosure at paragraph [0032]

does not associate the software programs with specific databases. Appellant must

consider the differences conventional because the disclosure was not written to include

specific permutations. Therefore, the new matter of Appellant's disclosure is "a first

program" that performs a specific function and a "second program" that performs a

different function, not the concept of "a first software program" and "a second software

program".

Appellant argues – "Bernklau-Halvor fails to disclose a system having an error

database that receives error messages from multiple printers, wherein error

messages are automatically generated and conveyed over a network to the least

one online error database upon detection of an error. "

Appellant has used paragraph [0005] to support the "automatically generated" error

messages. However, the passage refers to the advantages of "automatically" collecting

the error messages. Therefore, Bernklau-Halvor taught "conveying" the error messages

as claimed.

Appellant argues – "In contrast, Bernklau-Halvor only transmits the usage profile

record after the user has specifically requested support for the printer. (See

column 2, lines 21-65). Until such a request is made by the user, the usage profile

information is, at most, stored in the printer itself (See column 4, lines 46-50;

column 5, line 16-18)." "As noted above, this information is submitted when a

request for service is made by the user of the printer."

The claim language in question is "automatically generating", it is clear from Bernklau-Havlor that the request for retrieval of printer information is from a datastore. Appellant admits the Bernklau-Halvor taught "when a request for service is made to the supply server 12, the support server will request any usage profile information stored about the printer ..." The printer information had to be previously stored (emphasis added) in database 116 in order to be available to be supplied after the request. The stored printer information was "automatically" generated and then conveyed upon request which is within the scope of Appellant's claim.
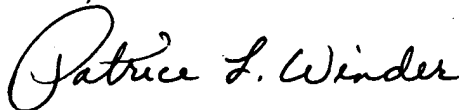
(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

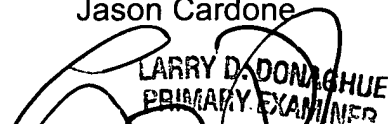**PATRICE WINDER**
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